

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

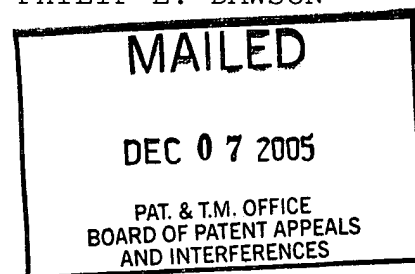
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Ex parte STEPHEN B. H. KENT, TOM W. MUIR and PHILIP E. DAWSON

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Application No. 09/710,633

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on October 27, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that the appeal brief filed May 2, 2005, did not fully comply with 37 CFR § 41.37(c).

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37 CFR § 41.37(c) states in part:

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following appropriate sections are missing from the appeal brief filed May 2, 2005:

- 1) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

A supplemental appeal brief in compliance with 37 CFR § 41.37 is required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

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<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Also, On each October 31, 2005, and November 28, 2005, appellants filed a reply brief with an extension of time in response to the Examiner's answer mailed August 23, 2005. However, there is no indication on the record whether or not the examiner has responded to the reply briefs. Section § 1208.03 of the Manual of Patent Examining Procedure (8<sup>th</sup> ed., Aug. 2001) states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. . . . The primary must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02 [emphasis added].

The examiner should also consider the timeliness of each of the reply briefs in view of the fact that extensions of time under 37 CFR § 1.136(a) are not permitted.

Furthermore, the examiner's answer filed on August 23, 2005, does not comply with the heading as set forth in the new rules under 37 CFR § 41.37(c). Correction is required.

Accordingly, it is

**ORDERED** that this application be returned to the examiner to: 1) hold the appeal brief of May 2, 2005 defective; 2) request appellants to file a supplemental appeal brief in


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compliance with 37 CFR § 41.37; 3) vacate the examiner's answer and provide a revised examiner's answer in accordance with the new rules effective September 13, 2004 in response to the supplemental appeal brief; 4) for proper response to the reply briefs filed October 31, 2005, and November 28, 2005; and 5) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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